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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,812	08/04/2004	Adam Edwin Behringer	BEED011001	4811

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EXAMINER

LY, CHEYNE D

ART UNIT PAPER NUMBER

2168

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/710,812

Applicant(s)

BEHRINGER, ADAM EDWIN

Examiner

Cheyne D. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-33 are examined on the merits.

### **CLAIM REJECTIONS - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 13, and 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawrie et al. (1999) (Lawrie hereafter).

### **CLAIM INTERPRETATIONS**

4. The disclosure of files such as text and TIFF files has been interpreted to inherently comprise “filenames.”

### **PRIOR ART**

5. In regard to claim 1, Lawrie discloses a method comprising:

Receiving a plurality of hard copy documents (page 499, column 1, Introduction section, and page 500, column 1, lines 10-13);

Creating a digital hierarchical directory structure for representing the plurality of hard copy documents (page 499, column 2, lines 16-23), wherein the digital hierarchical directory structure includes physical attribute information, physical attribute information being associated with at least one of the containers or the documents, physical attribute information includes a descriptor associated with one or more of the physical attributes of the associated container (page 501, column 1, section 3.1, The Database, and column 2,

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section 3.2, especially, “hierarchical organization of a collection” of a documents in a file cabinet);

Generating digital copies of each of the plurality of hard copy documents (page 500, column 2, section 3, The System Description section, especially, “Scanning”); and

Storing the generated digital copies based on filenames associated with the physical attribute information, wherein the received plurality of hard copy documents are received in one or more containers, each container having one or more actual physical attributes (page 500, column 1, lines 10-17, especially, TIFF files, and page 501, column 1, section 3.1, The Database, especially, “the files are ‘thumbed through’ to find the correct one”).

6. In regard to claims 2 and 3, Lawrie discloses searching the digital hierarchical directory structure; and retrieving one or more of the digital copies based on the search (page 501, column 1, section 3.1, The Database, and column 2, section 3.2, especially, “the file cabinet can be queried...or any combination of these attributes”).
7. In regard to claim 4, Lawrie discloses transforming the digital hierarchical directory structure between two or more of filenames storage format, a structured text format (page 500, column 1, lines 10-23, especially, “ASCII...version of the document...in the form of text”), or a relational database format (page 501, column 1, Section 3.1, The Database).
8. In regard to claim 5, Lawrie discloses physical attribute information is stored in a filemanes storage format, a structure text format, or a relational database format (page 501, column 1, Section 3.1, The Database, especially, “we created a database indexed by words, color, and physical information”).

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9. In regard to claims 13 and 21-25, Lawrie disclose the interface (page 502, columns 1-2, section 3.3) and computer-based system (page 500, column 2, section 3, The System Description) for implementing the above-cited method.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 6-12, 14-20, and 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrie et al. (1999) (Lawrie hereafter) as applied to claims 1-5, 13, and 21-25 above, and further in view of Fox et al. (1993) (Fox hereafter).

**MOTIVATION TO COMBINE**

12. Fox describes "it is important not only improve the user interfaces, but also to provide assistance to users like that offered by experienced librarians and search intermediates (page 482, column 2, last paragraph). Therefore, one of ordinary skill in the art at the time of the invention would have been motivated by Fox to improve the user interface described by Lawrie (page 502, columns 1-2, section 3.3).

**PRIOR ART**

13. In regard to claims 6-12, 14-20, and 26-32, Lawrie describes all the limitations of said claims except for the limitation of icons. Further, Lawrie describes the "buttons include changing the size of the file cabinet" (page 503, column 1, lines 8-15). A drawer is recommended on the basis of the greatest number of...documents.." (page 500, column 1,

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lines 22-24). Fox describes improvements to a user interface with the use icons as directed to icon placement, size, color, and shape (page 487, columns 1-2, especially, the last 3 lines of column 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the user interface described by Lawrie with the icons of Fox.

14. In regard to claim 33, Lawrie describes all the limitations of said claims except for the limitation of network. Fox describes an improvement "to help with search and browsing...the WorlWideWeb" (network) (page 482, column 1, lines 8-36). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the user interface described by Lawrie with the icons of Fox "to help with search and browsing...the WorlWideWeb" (network).

### CONCLUSION

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Hill et al., Journal of the American Society for Information Science, 50(13), pages 1169-1181, 1999.

Frew et al., Int. J Digit Libr, 2, pages 259-268, 2000.

Janee et al., JCDL'02, July 13-17, 2002, Portland, Oregon, USA, pages 342-350.

16. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image

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problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

17. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-

9199. The USPTO's official fax number is 571-272-8300.


18. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tim Vo, can be reached on (571) 272-3642.

C. Dune Ly   
Patent Examiner

10/29/06